



01-09-06

AF/3724
ZRW

Practitioner's Docket No. 019502.0007US1

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Earl J. Votolato

Application No.: 10/010,158
Filed: 11/13/2001
For: BAG SLITTING APPARATUSGroup No.: 3724
Examiner: Payer, Hwei Siu ChouMail Stop Appeal Briefs – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450TRANSMITTAL OF APPEAL BRIEF
(PATENT APPLICATION--37 C.F.R. § 41.37)

1. Transmitted herewith, in triplicate, is resubmission of the response to Notice of Non-Compliant Appeal Brief issued on December 9, 2005.
2. STATUS OF APPLICANT

This application is on behalf of a small entity. A statement was already filed.

CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10*
(When using Express Mail, the Express Mail label number is **mandatory**;
Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

MAILING

G deposited with the United States Postal Service in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

37 C.F.R. § 1.8(a)
G with sufficient postage as first class mail.**37 C.F.R. § 1.10***
☒ as "Express Mail Post Office to Addressee"
Mailing Label No. EV723229762US (**mandatory**)**TRANSMISSION**

G facsimile transmitted to the Patent and Trademark Office, (571) _____

Date: 1/5/06

Signature

Jacquelyn Campbell

(type or print name of person certifying)

* Only the date of filing ('1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under '1.8 continues to be taken into account in determining timeliness. See '1.703(f). Consider "Express Mail Post Office to Addressee" ('1.10) or facsimile transmission ('1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

3. TOTAL FEE DUE

The total fee due is:

Appeal brief fee	\$0.00
Extension fee (if any)	\$0.00

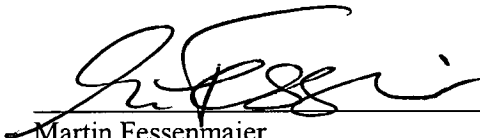
TOTAL FEE DUE \$0.00

4. FEE PAYMENT

The fees for filing the Appeal Brief were paid in the previous submission on September 26, 2005. However, if any additional extension and/or fee is required, and if any additional fee for claims is required, authorization is hereby give to charge Deposit Account No. 502191.

Date:

01/05/06



Martin Fessenmaier
Registration No. 46697
Rutan & Tucker, LLP
611 Anton Blvd., Suite 1400
Costa Mesa, CA 92626
US
714-641-5100
Customer No. 34284



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
GROUP ART UNIT 3611**

EXAMINER: Payer, Hwei Siu Chou.
APPELLANT: Earl J. Votolato
SERIAL NO. 10/010,158
FILED: November 13, 2001
FOR: Bag Slitting Apparatus
ART UNIT 3724

MS Appeal Brief - Patents
Commissioner of Patents and Trademarks
Washington, D.C. 20231
Attention: Board of Patent Appeals and Interferences

APPELLANT'S BRIEF UNDER 37 CFR § 1.192

This brief, transmitted in triplicate, follows the appellant's Notice of Appeal filed in this case on July 25, 2005.

The fees required under § 1.17, and any required petition for extension of time for filing this brief and fees therefor, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains the following items under the headings in the order here indicated:

- I. Real Party In Interest
- II. Related Appeals And Interferences
- III. Status Of Claims
- IV. Status Of Amendments
- V. Summary Of Claimed Subject Matter
- VI. Grounds of Rejection To Be Reviewed On Appeal

VII. Argument

VIII. Claims Appendix

IX. Evidence Appendix

X. Related Proceedings Appendix

I. Real Party In Interest

The real party in interest is the Applicant, Earl J. Votolato.

II. Related Appeals And Interferences

There are no other appeals or interferences in this matter known to appellant.

III. Status Of Claims

1. Claims canceled: 2-3;
2. Claims pending: 1, 4-7;
3. Claims rejected: 1, 4-7; and
4. Claims on appeal: 1, 4-7.

IV. Status Of Amendments

Amendments were filed after final rejection, and the amendments were entered by the Examiner as indicated in the subsequently issued Advisory Action dated July 6, 2005. The claims as entered remain rejected for the same grounds as presented before by Examiner in the final rejection. Section IX recites the claims as entered/pending and under final rejection.

V. Summary Of Claimed Subject Matter

The invention is directed to a bag slitting apparatus for opening a sealed bag (See *e.g.*, Figures 1 and 3, Number 10; Specification page 1, lines 12-19). More specifically, the apparatus has first and second arms forming a single piece of material (*e.g.*, Figures 1-4, and page 4, lines 24-25) that are connected only through a pivoting bridge at one end (*e.g.*, Figures 1-4, and page 4, lines 4-9), and wherein the arms have outer surfaces that are concavely contoured distally for simultaneous receipt of

a finger and a thumb of a user (*e.g.*, Figures 2-3, and page 4, lines 14-19) . The first arm carries a cutting surface on an interior surface facing the second arm, and the second arm carries a receiving surface that cooperates with the cutting surface (*e.g.*, Figures 2-4, and page 4, lines 9-14) to make a cut through a portion of the bag when the first and second arms are opposed about the bag (*e.g.*, Figure 3, and page 5, lines 7-9), wherein the first and second arms are each distally significantly wider than the bridge (*e.g.*, Figure 1).

VI. Grounds of Rejection To Be Reviewed On Appeal

1. Rejection of claims 1, and 4-7 under 35 U.S.C. § 112 as failing to comply with the written description requirement (Final Office Action, items (1), (2), and (3) spanning pages 2 and 3).
2. Rejection of claims 1, 4, 6, and 7 under 35 U.S.C. § 103 as being obvious over Horning (U.S. Pat. No. 5,007,171) in view of Pankonin (U.S. Pat. No. 2,033,050) and Hanna (U.S. Pat. No. 5,357,679) (Final Office Action, page 3).
3. Rejection of claims 5 under 35 U.S.C. § 103 as being obvious over Horning in view of Pankonin and Hanna and further view of Braatz (U.S. Pat. No. 5,103,562) (Final Office Action, page 4).

VII. Argument

1. Rejection under U.S.C. § 112 , first paragraph

Claims 1, and 4-7 were rejected under 35 USC § 112 as failing to comply with the written description requirement. More specifically, the Examiner held that the elements (1) "the first and second arms are each significantly wider than the bridge", (2) "the receiving surface is curved", and (3) "entirety of the first and second arms extend concavely from the bridge" were not described as originally filed. The Applicant disagrees.

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that *one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention* (see, e.g., *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116). Furthermore, it is well accepted that a *satisfactory description may be in the claims or any other portion* of the originally filed specification. Among other things, an applicant *shows possession* of the claimed invention by describing the claimed invention with all of its limitations *using such descriptive means as words, structures, figures, diagrams, and formulas* that fully set forth the claimed invention (see e.g., *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997)). Thus, possession may be shown in a variety of ways, including the disclosure of drawings.

The analysis of whether the specification complies with the written description requirement is conducted from the *standpoint of one of skill in the art* at the time the application was filed (see, e.g., *Wang Labs. v. Toshiba Corp.*, 993 F.2d 858, 865, 26 USPQ2d 1767, 1774 (Fed. Cir. 1993)). A description as filed is *presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner* to rebut the presumption. See, e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). Moreover, the *examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the original disclosure a description* of the invention defined by the claims. See *Wertheim*, 541 F.2d at 263, 191 USPQ at 97 ("[T]he PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.").

(1) "...First And Second Arms Are Each Significantly Wider..."

With respect to claim 1, the applicant is of the position that Figure 1 in the context of the remaining specification unmistakably depicts a bag opener in which the first and second arms are each significantly wider than the bridge at least in some portion. In the response after final, the applicant further amended claim 1 to read "...first and second arms are each distally significantly wider than the bridge..." Such *limitation can unquestionably be identified in Figures 1 and 4*. A

person of ordinary skill in the art of business tools would reasonably be expected to identify the claimed limitation as the Figures are of near-photographic accuracy and the perspective view of Figure 1 clearly allows identification of the limitation. Therefore, it is the applicant's position that the above limitation is adequately described.

In her response, the Examiner maintained her position that Figures 1 and 4 would not disclose such feature, however, ***fails to provide sufficient evidence or reasoning to support such allegation*** despite the applicant's earlier express request.

(2) "*...The Receiving Surface Is Curved...*"

With respect to claim 6, the applicant is of the position that the bag opener is depicted ***in Figures 2 and 4*** in a manner that allows a person of ordinary skill in the art to clearly recognize that the ***receiving surface is curved (see numeral 32)***. Such curvature is expressly depicted in Figures 2 and 4 using a curved line.

Once more, the Examiner maintained her position in her response that claim 6 would have no support from the specification. Unfortunately, the Examiner again ***failed to provide sufficient evidence or reasoning to support such allegation*** despite the applicant's express request.

(3) "*...Entirety Of The First And Second Arms Extend Concavely From The Bridge...*"

With respect to claim 7, it is the applicant's position that the bag opener is depicted in both ***Figures 2 and 4*** such as to unmistakably allow a person of ordinary skill in the art to recognize that the ***entirety of the first and second arms extend concavely from the bridge***. Such limitation is consistent with the limitation in the parent claim 1 that the "...outer surfaces...are concavely contoured distally for simultaneous receipt of a finger and a thumb of a user. Literal support is provided in the specification on numerous occasions (see e.g., page 4, line 16 et seq.).

In her response, the Examiner remarkably argued that the inner surfaces would be convexly contoured and that therefore claim 7 would lack adequate support. At best, such ***argument is a non sequitur argument***. Alternatively, it could also be argued that the ***Examiner's position in fact provides supports to the claimed limitation*** as the flipside of a concave surface is a convex surface

(provided that the curved element has uniform thickness as could be reasoned from the Figures). Therefore, the Examiner again *failed to provide sufficient evidence or reasoning to support her allegation.*

2. Rejection under U.S.C. § 103(a) (Horning-Pankonin-Hanna)

Claims 1, 4, 6, and 7 were rejected under 35 U.S.C. § 103 as being obvious over Horning (U.S. Pat. No. 5,007,171) in view of Pankonin (U.S. Pat. No. 2,033,050) and Hanna (U.S. Pat. No. 5,357,679). In attempting to support such rejection, the Examiner recites various elements of the claims pointing to their alleged counterparts in the references and argued that:

(a) it would have been obvious to modify Horning by making the exterior surfaces and the entirety of the first and second arms concaved to enhance manual grasping of the first and second arms as taught by Pankonin; and

(b) it would have been obvious to further modify Hanna by making the bridge narrower than the arms to allow for more convenient opening and closing of the arms as taught by Hanna.

To properly establish *prima facie* obviousness of a claimed invention, ***all claim limitations must be taught or suggested by the prior art*** (see e.g., In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)).

Furthermore, it is well recognized that the factual inquiry whether to combine references must be thorough and searching." ***It must be based on objective evidence of record.*** See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'"). The courts have held that "...teachings of references can be ***combined only if there is some suggestion or incentive to do so.*** (quoting ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). Indeed, ***particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed*** (see, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d

1313, 1317 (Fed. Cir. 2000)). ."); Thus, the examiner can satisfy the burden of showing obviousness of the combination "***only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art*** would lead that individual to combine the relevant teachings of the references In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

As presently pending, each of the claims expressly requires that the "...outer surfaces [of both arms]...are concavely contoured distally for simultaneous receipt of a finger and a thumb of a user..." This element is clearly neither taught nor suggested by any of the cited references. On the contrary, Horning and Pankonin teach flat arms, while the tool of Hanna has levers that are configured to receive the palm and a plurality of fingers. The ***only thing the three references provide is an arguable and incomplete collection of elements found in the claims***. However, there is absolutely ***no suggestion or motivation to modify/combine the references to arrive at the subject matter as presently claimed***.

Regrettably, the Office fails to offer any reasoning on the record as to why the claims were deemed obvious (see page 4 present office action, line 7 and line 14): While the Examiner alleges that Pankonin teaches enhancing of manual grasp by virtue of using concave arms, there is ***nothing in Pankonin to support that statement***. Even if Pankonin could be read that way (which is not the case), it would be to enhance manual grasp, and ***not grasp between a finger and a thumb of a user***. Therefore, not all of the elements as presently claimed are disclosed by the cited references.

Similarly, the Examiner refers to Hanna's teaching of narrowing of a bridge relative to the arms to allow for more convenient opening and closing of the arms, however, fails to provide such passage with the suitable context. While Hanna expressly points out that "...since the plates are made of a memory-retentive polymeric material, such as polycarbonate, it is important to minimize the area of connection between the first plate and the second plate..." Clearly, ***such context is inconsistent, if not even contrary to the alleged motivation provided by the Examiner***. Thus, the Office further fails to provide sufficient motivation to combine the cited references.

3. Rejection under U.S.C. § 103(a) (Horning-Pankonin-Hanna-Braatz)

Claim 5 was rejected under 35 U.S.C. § 103 as being obvious over Horning in view of Pankonin and Hanna and further view of Braatz (U.S. Pat. No. 5,103,562). Specifically, the *Examiner appears to argue that Braatz would teach to employ a metal blade to improve wear resistance. Such statement is entirely unsupported.* All that Braatz teaches is that the cutter may be a sharp steel component. Thus, Braatz does not provide the teaching, suggestion, and motivation as alleged by the Examiner. With respect to the Horning, Pankonin, and Hanna references, the same considerations as provided above apply.

Furthermore, claim 5 depends on claims 4 and 1. As Braatz fails to remedy the defects for establishing obviousness as discussed above, obviousness can also not properly established for that reason.

Conclusion Of Argument

In rejecting the presently pending claims, the Office failed to provide conclusive arguments as to why selected claims would not be adequately supported. The Office further failed to properly establish prima facie obviousness by ignoring expressly recited elements, and by further failing to provide proper suggestion or motivation in the references why the cited references should be combined. Based on the arguments provided above, it is the applicant's position that the rejections should be withdrawn.

Respectfully submitted,



Martin Fessenmaier, Ph.D.
Reg. No. 46,697
Agent for Appellant

Dated: January 4, 2006

Rutan & Tucker, LLP
P.O. Box 1950
611 Anton Blvd., Suite 1400
Costa Mesa, CA 92628-1950
Tel: 714-641-5100
Fax: 714-546-9035

VIII. CLAIMS APPENDIX

1. (previously presented) A bag slitting apparatus for opening a sealed bag, comprising:

first and second arms forming a single piece of material that are connected only through a pivoting bridge at one end, and wherein the arms have outer surfaces that are concavely contoured distally for simultaneous receipt of a finger and a thumb of a user;

the first arm carrying a cutting surface on an interior surface facing the second arm;

the second arm carrying a receiving surface that cooperates with the cutting surface to make a cut through a portion of the bag when the first and second arms are opposed about the bag, and

wherein the first and second arms are each distally significantly wider than the bridge.
2. (Canceled)
3. (Canceled)
4. (Previously presented) A bag slitting apparatus as claimed in Claim 1 wherein the arms and the bridge are fabricated as a single piece of plastic
5. (Previously presented) A bag slitting apparatus as claimed in Claim 4 wherein the cutting surface is an edge of a metal blade.
6. (Previously presented) A bag slitting apparatus as claimed in Claim 1 wherein the receiving surface is curved.
7. (Previously presented) A bag slitting apparatus as claimed in Claim 1 wherein the entirety of the first and second arms extend concavely from the bridge.

IX. EVIDENCE APPENDIX

No evidence was submitted pursuant to §§ 1.130, 1.131, or 1.132

X. RELATED PROCEEDINGS APPENDIX

No related proceedings are known to the applicant.